

REMARKS

Initially, Applicant would like to thank the Examiner for the indication that claims 51-56 contain allowable subject matter.

Claims 43 and 45-81 are currently pending.

The Office Action rejected claims 43, 45-50, 57-60, 62, 63 and 65-81 under 35 U.S.C. § 102 as anticipated by U.S. patent 6,491,931 ("Collin"), claims 43, 59-63, 65 and 69-81 under 35 U.S.C. § 102 as anticipated by U.S. patent 6,726,917 ("Kanji"), and claims 43, 45-50 and 57-81 under 35 U.S.C. § 103 as obvious over Collin and U.S. patent 5,911,974 ("Brieva"). The Office Action also rejected claims 43, 45-50, 59-63, 65 and 69-80 under the judicially created doctrine of obviousness-type double patenting as obvious over the claims in Collin. In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of these rejections.

In maintaining these rejections, the Office Action noted that Applicant had not presented evidence demonstrating the difference between the required rigid, substantially rectilinear fibers and the flexible fibers in the applied art. To address this concern, Applicant submits herewith a Rule 132 declaration demonstrating the difference between these two types of fibers.

By way of background, the claimed invention relates to compositions comprising rigid, substantially rectilinear polymeric fibers. The claimed rigid, rectilinear fibers are chosen from a select group of available materials: the polymer is selected from the group consisting of polyurethanes, polyesters, acrylic polymers, polyolefins, non-aromatic polyamides, aromatic polyimide-amides, and mixtures thereof. Nothing in any of the applied

art teaches or suggests including the required rigid, substantially rectilinear polymeric fibers made from the required materials in a cosmetic composition, let alone any of the benefits associated with the inclusion of such fibers in a cosmetic composition (for example, improved eyelash lengthening properties). In short, the applied art would not lead one skilled in the art to the claimed invention and, thus, neither teaches nor suggests the claimed invention.

In the past, only flexible fibers have been used in mascara compositions. Such flexible fibers do not satisfy the rigidity requirements now set forth in claim 43. (See, page 6, lines 13-31 of the present specification, particularly lines 21-26, for further explanation of the claimed rigidity requirements). The present invention represents the first time that rigid, substantially rectilinear polymeric fibers have been used in a cosmetic composition, particularly a mascara composition. Thus, when the applied art refers to “fibers,” it refers to conventional, flexible fibers which do not satisfy the required definition of rigidity. That is, the applied art teaches or suggests only conventional compositions containing flexible fibers. Nowhere does any of the art upon which the rejections are based teach or suggest using the required rigid, substantially rectilinear polymeric fibers.

For example, Collin discloses polyamide fibers sold by P. Bonte (col. 2, lines 54-56; example 1). As demonstrated in the Rule 132 declaration submitted concurrently herewith, such polyamide fibers are flexible, not rigid and substantially rectilinear as required by the pending claims.

More specifically, Tab A of the declaration includes photographs of (a) polyamide fibers (polyamide 6-6, 0.9 DTex, 3 mm), commercially available from Paul Bonte; and (b)

polyimide-amide fibers (Kermel Tech, 2 mm) commercially available from Rhodia. Both types of fibers were added to the identical cosmetic base compositions.

As can be seen from the first photograph in Tab A, the polyamide fibers from Paul Bonte formed curved, non-linear structures. (Rule 132 declaration, par. 2). In contrast, the polyimide-amide fibers formed substantially linear structures. (Rule 132 declaration, par. 2). These photographs demonstrate that the polyamide fibers are flexible, not rigid and substantially rectilinear as required by the present claims, whereas the polyimide-amide fibers are rigid and substantially rectilinear. (Rule 132 declaration, par. 2).

The Rule 132 declaration also discusses the fact that the mascara of example 1 of the present application was prepared, as well as a comparative example substantially identical to example 1 (except that it contained 1 g of 3 mm Nylon polyamide fibers). (Rule 132 declaration, par. 3). As described in paragraph 4 of the declaration, the angle formed between the tangent to the central longitudinal axis of the fiber at one of the ends of the fiber and the straight line connecting said end to the point on the central longitudinal axis of the fiber corresponding to half the length of the fiber was measured, as well as the angle formed between the tangent to the central longitudinal axis of the fiber at a point halfway along the fiber and the straight line connecting one of the ends to the point on the central longitudinal axis of the fiber corresponding to half the length of the fiber. The results of these measurements demonstrate that the polyamide fibers are flexible, not rigid and substantially rectilinear as required by the claims in the present application, whereas the polyimide-amide fibers are rigid and substantially rectilinear. (Rule 132 declaration, par. 4).

This evidence demonstrates that Collin neither teaches nor suggests using the required rigid fibers. No evidence to the contrary is of record. In other words, one skilled in the art, following Collin, would not be led to using the claimed rigid, substantially rectilinear fibers.

Kanji briefly discusses adding fibers to his compositions. However, nowhere does Kanji teach or suggest adding the required rigid, substantially rectilinear polymeric fibers to his compositions. Rather, Kanji's brief disclosure relating to fibers, like Collin's disclosure, relates to using conventionally known fibers (that is, flexible fibers) in his compositions, and nothing in Kanji leads to a different conclusion. Moreover, Kanji's examples 1 and 2 contain rayon flock fibers and, thus, contain fibers of a different chemical nature than the claimed fibers. In short, no disclosure in Kanji relates to a rigid, substantially rectilinear polymeric fiber selected from the group consisting of polyurethanes, polyesters, acrylic polymers, polyolefins, non-aromatic polyamides, aromatic polyimide-amides, and mixtures thereof. Given this complete absence of disclosure, Applicants respectfully submit that it is improper to require Applicants to demonstrate that Kanji's fibers are different -- Kanji does not contain enough of a disclosure with respect to the subject matter of the present invention upon which a meaningful comparison could be based.

Brieva, which is merely cited for its disclosure of an anhydrous composition, cannot compensate for Collin's and Kanji's deficiencies. None of the applied art would lead one skilled in the art to use the required rigid, substantially rectilinear polymeric fibers in a cosmetic composition. It is not merely a matter of substituting one type of fiber (rigid, substantially rectilinear fiber not used before in cosmetics) for another type of fiber (flexible, commonly used in cosmetics) and obtaining an expected result. Rather, it would constitute

substituting a different type of fiber for the flexible fibers typically used in the cosmetic industry, where no motivation would have existed to do so. Moreover, such a substitution would lead to substantially different results, particularly with respect to eyelash lengthening.

The difference between flexible and rigid polymeric fibers is substantial. As noted in the present application at pages 6-7, the conceptual difference between the required rigid fibers and conventional flexible fibers can be analogized to the difference between uncooked spaghetti (rigid fiber) and cooked spaghetti (flexible fiber), and this physical difference in fibers results in significant differences in effect of the fibers, particularly with respect to lengthening of eyelashes: the rigidity of the claimed fibers allows for better arrangement of fibers in relationship to eyelashes, providing an enhanced lengthening effect, whereas the flexibility of conventional fibers results in more random arrangement of fibers, meaning that the lengthening effect is inferior.

Nowhere does any of the applied art teach or suggest using the required rigid, substantially rectilinear polymeric fibers, or any benefits arising from such use.

For all of the above reasons, Applicant respectfully requests reconsideration and withdrawal of the pending rejections under 35 U.S.C. §§ 102 and 103.

Regarding the double patenting rejections, Applicant respectfully requests reconsideration and withdrawal of these rejections for the same reasons. The claims in Collin and Kanji, like the disclosures in these references, neither teach nor suggest the required rigid polymeric fibers. In other words, the claims in these references would not lead one skilled in the art to the invention compositions containing the required rigid polymeric fibers. Rather,

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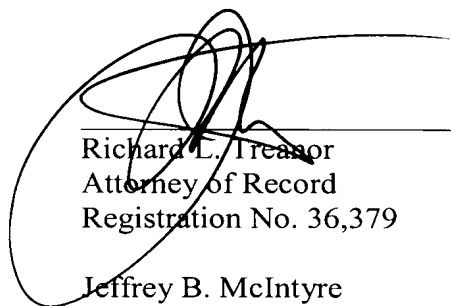
the claims in these references would only lead to conventional compositions containing flexible fibers.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the pending double patenting rejections.

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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A large, stylized handwritten signature in black ink, appearing to be 'Richard L. Treasor', is written over a horizontal line.

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